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APPLICATION NO.	FILING DATE	FIRST NAMED INVENTOR	ATTORNEY DOCKET NO.	CONFIRMATION NO.
10/808,124	03/24/2004	William Bedingham	56545US007	4531
32692	7590	01/14/2010		
3M INNOVATIVE PROPERTIES COMPANY				
PO BOX 33427				
ST. PAUL, MN 55133-3427				
EXAMINER				
ALEXANDER, LYLE				
ART UNIT		PAPER NUMBER		
1797				
NOTIFICATION DATE		DELIVERY MODE		
01/14/2010		ELECTRONIC		

**Please find below and/or attached an Office communication concerning this application or proceeding.**

The time period for reply, if any, is set in the attached communication.

Notice of the Office communication was sent electronically on above-indicated "Notification Date" to the following e-mail address(es):

LegalUSDocketing@mmm.com

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# Office Action Summary

**Application No.**

10/808,124

**Applicant(s)**

BEDINGHAM ET AL.

**Examiner**

LYLE A. ALEXANDER

**Art Unit**

1797

-- The MAILING DATE of this communication appears on the cover sheet with the correspondence address --  
**Period for Reply**

A SHORTENED STATUTORY PERIOD FOR REPLY IS SET TO EXPIRE 3 MONTH(S) OR THIRTY (30) DAYS, WHICHEVER IS LONGER, FROM THE MAILING DATE OF THIS COMMUNICATION.

- Extensions of time may be available under the provisions of 37 CFR 1.136(a). In no event, however, may a reply be timely filed after SIX (6) MONTHS from the mailing date of this communication.
- If NO period for reply is specified above, the maximum statutory period will apply and will expire SIX (6) MONTHS from the mailing date of this communication.
- Failure to reply within the set or extended period for reply will, by statute, cause the application to become ABANDONED (35 U.S.C. § 133). Any reply received by the Office later than three months after the mailing date of this communication, even if timely filed, may reduce any earned patent term adjustment. See 37 CFR 1.704(b).

**Status**

- 1) ☒ Responsive to communication(s) filed on 02 November 2009.
- 2a) ☒ This action is **FINAL**. 2b) ☐ This action is non-final.
- 3) ☐ Since this application is in condition for allowance except for formal matters, prosecution as to the merits is closed in accordance with the practice under *Ex parte Quayle*, 1935 C.D. 11, 453 O.G. 213.

**Disposition of Claims**

- 4) ☒ Claim(s) 1-24 is/are pending in the application.
- 4a) Of the above claim(s) \_\_\_\_\_ is/are withdrawn from consideration.
- 5) ☐ Claim(s) \_\_\_\_\_ is/are allowed.
- 6) ☒ Claim(s) 1-24 is/are rejected.
- 7) ☐ Claim(s) \_\_\_\_\_ is/are objected to.
- 8) ☐ Claim(s) \_\_\_\_\_ are subject to restriction and/or election requirement.

**Application Papers**

- 9) ☐ The specification is objected to by the Examiner.
- 10) ☐ The drawing(s) filed on \_\_\_\_\_ is/are: a) ☐ accepted or b) ☐ objected to by the Examiner.  
Applicant may not request that any objection to the drawing(s) be held in abeyance. See 37 CFR 1.85(a).  
Replacement drawing sheet(s) including the correction is required if the drawing(s) is objected to. See 37 CFR 1.121(d).
- 11) ☐ The oath or declaration is objected to by the Examiner. Note the attached Office Action or form PTO-152.

**Priority under 35 U.S.C. § 119**

- 12) ☐ Acknowledgment is made of a claim for foreign priority under 35 U.S.C. § 119(a)-(d) or (f).
- a) ☐ All b) ☐ Some \* c) ☐ None of:
1. ☐ Certified copies of the priority documents have been received.
  2. ☐ Certified copies of the priority documents have been received in Application No. \_\_\_\_\_.
  3. ☐ Copies of the certified copies of the priority documents have been received in this National Stage application from the International Bureau (PCT Rule 17.2(a)).

\* See the attached detailed Office action for a list of the certified copies not received.

**Attachment(s)**

- 1) ☐ Notice of References Cited (PTO-892)
- 2) ☐ Notice of Draftsperson's Patent Drawing Review (PTO-948)
- 3) ☐ Information Disclosure Statement(s) (PTO/SB/C)
- 4) ☐ Interview Summary (PTO-413)  
Paper No(s)/Mail Date: \_\_\_\_\_
- 5) ☐ Notice of Informal Patent Application
- 6) ☐ Other: \_\_\_\_\_
- Paper No(s)/Mail Date: \_\_\_\_\_

### ***Double Patenting***

The nonstatutory double patenting rejection is based on a judicially created doctrine grounded in public policy (a policy reflected in the statute) so as to prevent the unjustified or improper timewise extension of the "right to exclude" granted by a patent and to prevent possible harassment by multiple assignees. A nonstatutory obviousness-type double patenting rejection is appropriate where the conflicting claims are not identical, but at least one examined application claim is not patentably distinct from the reference claim(s) because the examined application claim is either anticipated by, or would have been obvious over, the reference claim(s). See, e.g., *In re Berg*, 140 F.3d 1428, 46 USPQ2d 1226 (Fed. Cir. 1998); *In re Goodman*, 11 F.3d 1046, 29 USPQ2d 2010 (Fed. Cir. 1993); *In re Longi*, 759 F.2d 887, 225 USPQ 645 (Fed. Cir. 1985); *In re Van Ornum*, 686 F.2d 937, 214 USPQ 761 (CCPA 1982); *In re Vogel*, 422 F.2d 438, 164 USPQ 619 (CCPA 1970); and *In re Thornton*, 418 F.2d 528, 163 USPQ 644 (CCPA 1969).

A timely filed terminal disclaimer in compliance with 37 CFR 1.321(c) or 1.321(d) may be used to overcome an actual or provisional rejection based on a nonstatutory double patenting ground provided the conflicting application or patent either is shown to be commonly owned with this application, or claims an invention made as a result of activities undertaken within the scope of a joint research agreement.

Effective January 1, 1994, a registered attorney or agent of record may sign a terminal disclaimer. A terminal disclaimer signed by the assignee must fully comply with 37 CFR 3.73(b).

Claims 1-24 are rejected on the ground of nonstatutory obviousness-type double patenting as being unpatentable over claims 1-29 of U.S. Patent No. 6,720,187.

Although the conflicting claims are not identical, they are not patentably distinct from each other because both are directed to a sampling device having an input chamber and output chamber connected to each other by one or more chambers that are arranged in a circular arc.

The 11/2/09 terminal disclaimer was disapproved because there are more than 10 practitioners listed on the POA. A new POA and TD are required.

### ***Claim Rejections - 35 USC § 112***

1. The following is a quotation of the second paragraph of 35 U.S.C. 112:

The specification shall conclude with one or more claims particularly pointing out and distinctly claiming the subject matter which the applicant regards as his invention.

2. Claims 1-24 are rejected under 35 U.S.C. 112, second paragraph, as being indefinite for failing to particularly point out and distinctly claim the subject matter which applicant regards as the invention.

The claims specify "the spacing between each input chamber is regular in both the X and Y directions" which is unclear what structural limitations are intended by "regular". For the purposes of examination, it will be assumed the claimed limitation "regular" means the dimensions are identical or the same in both the X and Y directions.

***Claim Rejections - 35 USC § 103***

The text of those sections of Title 35, U.S. Code not included in this action can be found in a prior Office action.

Claims 1-24 are rejected under 35 U.S.C. 103(a) as being unpatentable over Kellogg et al. (USP 6,143,248) or EP 0693560.

See the appropriate paragraphs of the 10/15/07 Office action for the teachings of Kellogg et al. (USP 6,143,248) and EP 0693560.

Kellogg et al. teach in column 15 lines 13+ the use of capillary microvalves within the microchannels. The microchannels are placed between the fluid input and output chamber and have been properly read on the claimed "... at least one valve located between the input chamber and the output chamber."

EP'560 teaches in column 23 lines 17-21 that valves are used to control the fluid flow through the device. EP'560 is silent to the relative placement of the valves between the input chamber and the output chamber. The valves control the sample

flow within the device and to accomplish this function must be placed after the fluid input chamber and before the output chamber (e.g. if the valves are placed prior to the input chamber or after the output chamber the fluid in the device would not be affected by the valves.) It either would have been inherent the valves are between the input and output chamber or it would have been within the skill of the art to further modify EP'560 and place the valves between the input and output chambers to gain the above advantages of fluid control within the device.

Both Kellogg et al. (USP 6,143,248) and EP 0693560 teach plural processing arrays in a generally rectangular configurations but fail to specify the above requirements of "...the spacing between each input chamber is regular in both the X and Y directions .... such that the spacing between each output chamber is regular in both X and Y direction in a rectilinear grid array."

The court held that the configuration of the claimed container was a matter of choice which a person of ordinary skill in the art would have found obvious absent persuasive evidence that the particular configuration of the claimed container was significant.( In re Dailey, 357 F.2d 669, 149 USPQ 47 (CCPA 1966))

The selection of the arrays' configuration would have been a mater of choice. Also, the selection of rectangular configuration would have been advantageous to minimize the amount of space between each array. It would have been within the skill of the art to modify either Kellogg et al. (USP 6,143,248) or EP 0693560 and make the processing arrays with four identifiable comers at the junctions of four identifiable sides

and two major surfaces such that the spacing between the each chamber is the same in the X and Y directions as a matter of choice and to gain the above advantages.

### ***Response to Arguments***

Applicant's arguments filed 11/2/09 have been fully considered but they are not persuasive.

The remainder of Applicants' remarks stated that Kellogg et al. and EP'560 fail to teach the claimed "...the spacing between each input chamber is regular in both the X and Y directions." In light of the above 35 USC 112 second paragraph rejections, the Office best understands "regular" as meaning the dimensions are identical or the same in both the X and Y directions. Applicants' remark the cited prior art fails to teach claimed "regular in both the X and Y directions". Applicants arguments appear to be directed to a 35 USC 102 type of rejection by stating the prior art is not "identical" to the claimed invention. However, the rejections of record are 35 USC 103 rejection where the issue is if the cited prior art is an obvious variation and if there is sufficient motivation of record to make the variation. The Office maintains in the absence of a showing of unexpected results, one having ordinary skill in the art would have expected identical or similar results from the claimed "regular" structure and that such a change is within the skill of the art as described above.

Applicants' state the modifications of the cited prior art fail would not be obvious because the claimed configuration increases the amount of centrifugal force required to move the fluid. Applicants' are encouraged to provide a timely and proper 1.132

Declaration that is within the scope of the claims, that provides data demonstrating that more force is required by the claimed invention than the cited prior art. In the absence such a factual showing of unexpected results, the Office maintains that one having ordinary skill in the art would have expected identical or similar performance from the cited prior art and claimed "regular" arrays.

This is a continuation of applicant's earlier Application No. 10/808,124. All claims are drawn to the same invention claimed in the earlier application and could have been finally rejected on the grounds and art of record in the next Office action if they had been entered in the earlier application. Accordingly, **THIS ACTION IS MADE FINAL** even though it is a first action in this case. See MPEP § 706.07(b). Applicant is reminded of the extension of time policy as set forth in 37 CFR 1.136(a).

A shortened statutory period for reply to this final action is set to expire THREE MONTHS from the mailing date of this action. In the event a first reply is filed within TWO MONTHS of the mailing date of this final action and the advisory action is not mailed until after the end of the THREE-MONTH shortened statutory period, then the shortened statutory period will expire on the date the advisory action is mailed, and any extension fee pursuant to 37 CFR 1.136(a) will be calculated from the mailing date of the advisory action. In no, however, event will the statutory period for reply expire later than SIX MONTHS from the mailing date of this final action.

1.

Any inquiry concerning this communication or earlier communications from the examiner should be directed to LYLE A. ALEXANDER whose telephone number is (571)272-1254. The examiner can normally be reached on Monday through Thursday.

If attempts to reach the examiner by telephone are unsuccessful, the examiner's supervisor, Jill Warden can be reached on 571-272-1267. The fax phone number for the organization where this application or proceeding is assigned is 571-273-8300.

Information regarding the status of an application may be obtained from the Patent Application Information Retrieval (PAIR) system. Status information for published applications may be obtained from either Private PAIR or Public PAIR. Status information for unpublished applications is available through Private PAIR only. For more information about the PAIR system, see <http://pair-direct.uspto.gov>. Should you have questions on access to the Private PAIR system, contact the Electronic Business Center (EBC) at 866-217-9197 (toll-free). If you would like assistance from a USPTO Customer Service Representative or access to the automated information system, call 800-786-9199 (IN USA OR CANADA) or 571-272-1000.

/Lyle A Alexander/  
Primary Examiner, Art Unit 1797